IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) Ferdinand Hendriks, et al.		**Examiner:**	Duyen My Doan
Serial No: 10/081,941		**Art Unit:**	2152
Filed: February 22, 2002		**Docket:**	YOR920010731US1 (15160)
For: INK INSTANT MESSAGING WITH ACTIVE MESSAGE ANNOTATION		**Dated:**	March 09, 2007

Confirmation No: 4472

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

INTRODUCTION

Pursuant to 35 U.S.C. §134 and 37 C.F.R. §§1.191 and 1.192, entry of this Appeal Brief in support of the Notice of Appeal filed January 12, 2007 in the above-identified matter is respectfully requested. This paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 1-55 in the above-identified patent application on October 12, 2006.

CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this paper is being electronically transmitted to the Patent and Trademark Office on the date shown below.

Dated: March 09, 2007

Steven Fischman

1. STATEMENT OF REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is International Business Machines Corporation.

2. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no pending appeals or interferences related to this application to Appellants' knowledge.

3. STATEMENT OF THE STATUS OF THE CLAIMS

A. Claim Status

Claims 1-13, 18, 19-30, 35-47, and 52-55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,564,249 to Shiigi ("Shiigi") in view of U.S. Patent Publication No. 2002/0143994 to Sun et al. ("Sun"). Claims 14-17, 31-34, and 48-51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shiigi and Sun further in view of U.S. Patent No. 6,779,178 to Lloyd et al. ("Lloyd").

B. Appealed Claims

Claims 1-55 are appealed, a clean copy of which are attached hereto in Appendix A.

4. STATEMENT OF STATUS OF AMENDMENTS

The claims were not amended in the Response to the Final Rejection filed November 30, 2006.

5.   SUMMARY OF CLAIMED SUBJECT MATTER

The invention with respect to claim 1 comprises a method for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers (Abstract, Fig. 1, 101, 102, 106, 107, 108). The method with respect to claim 1 comprises establishing by at least some of the network of computers a connection to said instant messaging system (Fig. 1, 101, 102, page 7, lines 1-5 of the originally filed specification); providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field (Figs. 2 and 3, page 7, line 23 – page 8, line 14); displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session (Figs. 2 and 3, page 7, line 23 – page 8, line 14); directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record (Figs. 2 and 3, page 8, lines 7-9, lines 10-11, lines 22-25, page 10, lines 1-4, page 13, line 30 – page 14, line 1); distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field (page 9, lines 13-16).

The invention with respect to claim 2 comprises a method for messaging as claimed in claim 1, wherein said message objects are IM objects (page 7, lines 13-14, lines 21-23).

The invention with respect to claim 3 comprises a method for messaging as claimed in claim 1, further comprising copying a plurality of messages from other applications (page 7, line 10-11).

The invention with respect to claim 4 comprises a method for messaging as claimed in claim 1, wherein said messaging system is of a peer-to-peer type (page 2, lines 14-15).

The invention with respect to claim 5 comprises a method for messaging as claimed in claim 1, further comprising forwarding said handwritten stroke information to at least one participant (page 9, lines 13-16).

The invention with respect to claim 6 comprises a method for messaging as claimed in claim 1, wherein said messaging system updates chat record of all said current messages for distribution to, and handwritten stroke information annotation by, users of said messaging system, said method further comprising appending said handwritten stroke information onto said chat record (page 9, lines 13-16).

The invention with respect to claim 7 comprises a method for messaging as claimed in claim 1, wherein said establishing said connection is initiated by a first of a plurality of said users of said messaging system (Fig. 1, 101).

The invention with respect to claim 8 comprises a method for messaging as claimed in claim 7, wherein said graphical user interface comprises a handwritten stroke input field (Fig. 3, 15, page 7, lines 28-30).

The invention with respect to claim 9 comprises a method for messaging as claimed in claim 8, wherein said graphical user interface comprises an awareness field (Fig. 3, 14, page 7, line 30-page 8, line 1).

The invention with respect to claim 10 comprises a method for messaging as claimed in claim 8, wherein said graphical user interface comprises a text input field (Fig. 3, 2, page 8, lines 3-4).

The invention with respect to claim 11 comprises a method for messaging as claimed in claim 10, further comprising entering text into said text input field wherein said text is associated with said message objects for transmission to said messaging system (page 8, lines 3-4).

The invention with respect to claim 12 comprises a method for messaging as claimed in claim 8 further comprising entering handwritten stroke information into said handwritten stroke input field wherein said handwritten stroke information is associated with said message objects for transmission to said messaging system (page 7, lines 7-13).

The invention with respect to claim 13 comprises a method for messaging as claimed in claim 8, further comprising logging and displaying a complete history of said messages in said recording field of said graphical user interface (page 10, lines 4-7, page 12, line 11).

The invention with respect to claim 14 comprises a method for messaging as claimed in claim 13, wherein any one of said messages contains at least one URL for providing location information of an associated said message objects in said recording field (page 12, lines 15-17).

The invention with respect to claim 15 comprises a method for messaging as claimed in claim 14, wherein each of said plurality of users may navigate through said recording field to said associated said message objects by selecting said at least one URL whereby said associated said message objects are displayed to said plurality of users (page 13, line 25 - page 14, line 15).

The invention with respect to claim 16 comprises a method for messaging as claimed in claim 15, further comprising: annotating of said instant text messages in said recording field by any of said plurality of users; and using said hyperlink for alerting said plurality of users of said annotation (page 13, lines 25 – page 14, line 15).

The invention with respect to claim 17 comprises a method for messaging as claimed in claim 16, wherein said annotating comprises: a) navigating to a desired said message object in said recording field; b) selecting the desired said message to be annotated; and c) adding new handwritten stroke information message objects to said recording field (page 9, line 29 – page 10, line 4, page 13, lines 28 – page 14, line 2).

The invention with respect to claim 18 comprises a method for messaging as claimed in claim 13, further comprising searching said recording field based on user selected criteria (page 7, lines 16-18, page 8, lines 11-12).

The invention with respect to claim 19 comprises a computer program product comprising: a computer usable medium having computer readable program code embodied therein for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers (Abstract, Fig. 1, 101, 102, 106, 107, 108), the computer readable program code in said computer program product comprising: first computer readable program code for causing the computer to: a) establish a connection to said instant messaging system (Fig. 1, 101,

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102, page 7, lines 1-5); b) provide to a plurality of users via said instant messaging system a graphical user interface comprising a recording field (Figs. 2 and 3, page 7, line 23 – page 8, line 14); c)display in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session (Figs. 2 and 3, page 7, line 23 – page 8, line 14); d) receive directly input handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record (Figs. 2 and 3, page 8, lines 7-9, lines 10-11, lines 22-25, page 10, lines 1-4, page 13, line 30 – page 14, line 1); c) distribute via said instant messaging system said annotated one or more text messages for viewing by said plurality of users in said recording field (page 9, lines 13-16).

The invention with respect to claim 20 comprises a computer program product for messaging as claimed in claim 19, wherein said message objects are IM objects (page 7, lines 13-14, lines 21-23).

The invention with respect to claim 21 comprises a computer program product for messaging as claimed in claim 19, further comprising computer readable program code for causing the computer to copy a plurality of messages from other applications (page 7, line 10-11).

The invention with respect to claim 22 comprises a computer program product for messaging as claimed in claim 19, further comprising computer readable program code for causing the computer to forward said handwritten stroke information to at least one participant (page 9, lines 13-16).

The invention with respect to claim 23 comprises a computer program product for messaging as claimed in claim 19, further comprising computer readable program code for causing the computer to append said handwritten stroke information onto said chat record (page 9, lines 13-16).

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The invention with respect to claim 24 comprises a computer program product for messaging as claimed in claim 19, comprising computer readable program code for causing the computer to allow said establishing said connection to be initiated by a first of a plurality of users of said messaging system (Fig. 1, 101).

The invention with respect to claim 25 comprises a computer program product for messaging as claimed in claim 24, comprising computer readable program code for causing the computer to: a) include a handwritten stroke input field in said graphical user interface (Fig. 3, 15, page 7, lines 28-30).

The invention with respect to claim 26 comprises a computer program product for messaging as claimed in claim 25, comprising computer readable program code for causing the computer to provide an awareness field (Fig. 3, 14, page 7, line 30- page 8, line 1).

The invention with respect to claim 27 comprises a computer program product for messaging as claimed in claim 25, comprising computer readable program code for causing the computer to provide a text input field (Fig. 3, 2, page 8, lines 3-4).

The invention with respect to claim 28 comprises a computer program product for messaging as claimed in claim 27, comprising computer readable program code for causing the computer to make text entered into said text input field a part of said message objects (page 8, lines 3-4).

The invention with respect to claim 29 comprises a computer program product for messaging as claimed in claim 25, comprising computer readable program code for causing the computer to make handwritten stroke information entered into said handwritten stroke input field a part of said message objects (page 7, lines 7-13).

The invention with respect to claim 30 comprises a computer program product for messaging as claimed in claim 25, comprising computer readable program code for causing the computer to enable said recording field in said graphical user interface to log and display a complete history of said messages (page 10, lines 4-7, page 12, line 11).

The invention with respect to claim 31 comprises a computer program product for messaging as claimed in claim 30, comprising computer readable program code for causing the computer to place in any one of said messages at least one URL for providing location information of an associated said message objects in said recording field (page 12, lines 15-17).

The invention with respect to claim 32 comprises a computer program product for messaging as claimed in claim 31, comprising computer readable program code for causing the computer to provide each of said plurality of users the capability to navigate through said recording field to said associated said message objects by clicking on said at least one URL whereby said associated said message objects are displayed to said each of said plurality of users (page 13, line 25 - page 14, line 15).

The invention with respect to claim 33 comprises a computer program product for messaging as claimed in claim 32, comprising computer readable program code for causing the computer to: provide the capability of annotation of said messages in said recording field by any of said plurality of users; and alert said plurality of users of said annotation by said hyperlink (page 13, lines 25 – page 14, line 15).

The invention with respect to claim 34 comprises a computer program product for messaging as claimed in claim 33, comprising computer readable program code for causing the computer to provide the following capabilities in said annotation: a) navigation to a desired said message object in said recording field; b) selection of the desired said message to be annotated; and, c) addition of new handwritten stroke information message objects in said recording field (page 9, line 29 – page 10, line 4, page 13, lines 28 – page 14, line 2).

The invention with respect to claim 35 comprises a computer program product for messaging as claimed in Claim 30, comprising computer readable program code for causing the computer to provide searching of said recording field based on user selected criteria (page 7, lines 16-18, page 8, lines 11-12).

The invention with respect to claim 36 comprises a system for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers (Abstract, Fig. 1, 101, 102, 106, 107, 108) comprising: a) means for establishing a connection to said instant messaging system (Fig. 1, 101, 102, page 7, lines 1-5); b) means for providing to a plurality of users a graphical user interface comprising a recording field (Figs. 2 and 3, page 7, line 23 – page 8, line 14); c) means for displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session (Figs. 2 and 3, page 7, line 23 – page 8, line 14); d) means for directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one ore more text messages in said chat record (Figs. 2 and 3, page 8, lines 7-9, lines 10-11, lines 22-25, page 10, lines 1-4, page 13, line 30 – page 14, line 1); and e) means for distributing said annotated one or more instant text messages for viewing by said plurality of users in said recording field (page 9, lines 13-16).

The invention with respect to claim 37 comprises a system for messaging as claimed in claim 36, wherein: said message objects are IM objects (page 7, lines 13-14, lines 21-23).

The invention with respect to claim 38 comprises a system for messaging as claimed in claim 36 further comprising means for copying a plurality of messages from other applications (page 7, line 10-11).

The invention with respect to claim 39 comprises a system for messaging as claimed in claim 36, wherein said messaging system updates a record of all said current messages for

distribution to, and handwritten stroke information annotation by, users of said messaging service, said system further comprising means for forwarding said handwritten stroke information to at least one participant (page 7, lines 10-13, page 9, lines 13-16).

The invention with respect to claim 40 comprises a system for messaging as claimed in claim 36, further comprising means for appending said handwritten stroke information onto said chat record (page 9, lines 13-16).

The invention with respect to claim 41 comprises a system for messaging as claimed in claim 36, further comprising means for connecting, when initiated by a first of a plurality of users of said messaging system (Fig. 1, 101).

The invention with respect to claim 42 comprises a system for messaging as claimed in claim 41, further comprising: means for including a handwritten stroke input field in said graphical user interface (Fig. 3, 15, page 7, lines 28-30).

The invention with respect to claim 43 comprises a system for messaging as claimed in claim 42, comprising means for providing an awareness field (Fig. 3, 14, page 7, line 30- page 8, line 1).

The invention with respect to claim 44 comprises a system for messaging as claimed in claim 42, comprising means for inputting text (Fig. 3, 2, page 8, lines 3-4).

The invention with respect to claim 45 comprises a system for messaging as claimed in claim 44, comprising means for making said text a part of said message objects (page 8, lines 3-4).

The invention with respect to claim 46 comprises a system for messaging as claimed in claim 42, comprising means for making handwritten stroke information a part of said message objects (page 7, lines 7-13).

The invention with respect to claim 47 comprises a system for messaging as claimed in claim 42, comprising means for displaying a complete history of said messages (page 10, lines 4-7,

page 12, line 11).

The invention with respect to claim 48 comprises a system for messaging as claimed in claim 47, comprising means for providing location information of an associated said message objects of any one of said messages in said recording field (page 12, lines 15-17).

The invention with respect to claim 49 comprises a system for messaging as claimed in claim 48, comprising means for providing for each of said plurality of users, quick navigation through said recording field to said associated said message objects, whereby said associated said message objects are displayed to said each of said plurality of users (page 13, line 25 - page 14, line 15).

The invention with respect to claim 50 comprises a system for messaging as claimed in claim 49, comprising: means for annotating of said messages in said recording field by any of said plurality of users; means for alerting said plurality of users of said annotation (page 13, lines 25 – page 14, line 15, page 14, lines 25-28).

The invention with respect to claim 51 comprises a system for messaging as claimed in claim 50, comprising: means for navigating by a user to a desired said message object in said recording field; means for selecting the desired said message for annotation by said user; and means for adding said new handwritten stroke information message objects to said recording field (page 9, line 29 – page 10, line 4, page 13, lines 28 – page 14, line 2).

The invention with respect to claim 52 comprises a system for messaging as claimed in claim 47, comprising means for search of said recording field based on user selected search criteria (page 7, lines 16-18, page 8, lines 11-12).

The invention with respect to claim 53 comprises a method for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers (Abstract, Fig. 1, 101, 102, 106, 107, 108) comprising: establishing by at least some of

the network of computers a connection to said instant messaging system (Fig. 1, 101, 102, page 7, lines 1-5); providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field (Figs. 2 and 3, page 7, line 23 – page 8, line 14); displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session (Figs. 2 and 3, page 7, line 23 – page 8, line 14); directly inputting information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record (Figs. 2 and 3, page 8, lines 7-9, lines 10-11, lines 22-25, page 10, lines 1-4, page 13, line 30 – page 14, line 1); distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field (page 9, lines 13-16).

The invention with respect to claim 54 comprises a method for messaging as claimed in claim 53, further comprising: a. inputting said information message objects wherein said information comprises speech; b. annotating said information message objects wherein said annotating comprises speech (page 15, line 6).

The invention with respect to claim 55 comprises a method for messaging as claimed in claim 53, further comprising: a. inputting said information message objects wherein said information comprises gestures; b. annotating said information message objects wherein said annotating comprises gestures (page 9, lines 13-16).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review are:

whether claims 1-13, 18, 19-30, 35-47 and 52-55 are unpatentable under 35 U.S.C. §103(a)

over U.S. Patent No. 6,564,249 to Shiigi ("Shiigi") in view of U.S. Patent Publication No.

2002/0143994 to Sun et al. ("Sun"); and

whether claims 14-17, 31-34 and 48-51 are unpatentable under 35 U.S.C. §103(a) over

Shiigi and Sun further in view of U.S. Patent No. 6,779,178 to Lloyd et al. ("Lloyd").

7. ARGUMENTS

A. The rejection of claims 1-13, 18, 19-30, 35-47 and 52-55, on appeal, under 35 U.S.C. § 103, as being unpatentable over Shiigi in view of Sun is improper.

1. CLAIMS 1, 19, 36 and 53

In the Final Official Action, dated October 12, 2006, the Examiner rejected claims 1-

13, 18, 19-30, 35-47, and 52-55 under 35 U.S.C. § 103(a) as being unpatentable over Shiigi in view

of Sun.

Appellants respectfully disagree with the Examiner's characterization and

interpretation of the references cited and discussed in the Final Office Action. According to MPEP

§2142, to establish a prima facie case of obviousness, three basic criteria must be met. First, there

must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Office Action fails to establish the three basic criteria.

As understood by appellants, Shiigi discloses graphical email system that allows users to send, receive and view handwritten or handdrawn email messages. Sun as understood by appellants discloses a method and apparatus for implementing ink data communication between multiple parties using computing and/or communication devices on a network. Contrary to the Office Action, however, Shiigi and Sun fail to disclose, suggest, or teach every element claimed in independent claims 1, 19, 36, and 53. For instance, Shiigi and Sun, taken alone or in combination, do not disclose, suggest, or teach at least "a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session" and "directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record," as claimed in independent claims 1, 19, 36 and 53.

The Office Action cites Shiigi's abstract, col. 2, lines 1-36, col. 3, lines 40-67 as allegedly disclosing those elements. Those passages, however, refer to graphical capture area into which a user can enter handwritten or handdrawn input. Those passages do not disclose, suggest or teach "a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session." Further, while Shiigi appears to disclose an email system that handles handwritten or handdrawn messages, Shiigi lacks in suggesting or teaching "directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record."

Rather, Shiigi is concerned with sending and receiving graphical email independent and separate from any conventional text messages. Shiigi as understood by appellants provides a graphical capture area to handwrite or handdraw messages. The handwritten or handdrawn

messages are then converted to pixel data (screen coordinates, color, intensity) and sent to a server. A component on the server converts the pixel data to a gif file attachment to a standard email body. Shiigi does not disclose, suggest, or teach that its handwritten or handdrawn messages are "directly input ... anywhere within said recording field to thereby annotate said one or more instant text messages," but only that they are sent as graphics file as attachments to a standard email body.

Far from disclosing, suggesting or teaching to "annotate said one or more instant messages" with "information message objects," Shiigi explicitly discourages using text messages (see Shiigi, Col. 1, line 57 – Col. 2, line 19) and emphasizes, "The invention allows users to communicate using handwriting input rather than text input" (Shiigi, Col. 12, lines 8-11). Therefore, appellants believe that Shiigi does not disclose, suggest or teach to "directly input" handwritten stroke or other information message objects anywhere within the recording field having instant text messages from a currently ongoing instant text messaging session to thereby annotate the instant text messages in the chat record, as claimed in independent claims 1, 19, 36 and 53.

Similarly, while Sun appears to discuss communicating ink data using the current chat and instant messaging infrastructure, Sun like Shiigi also does not disclose, suggest or teach "directly inputting" ink data with instant messaging text data in an instant messaging or chat system in an ongoing instant messaging or chat session and thereby annotate the text message with ink data. Rather, Sun as understood by appellant discloses using instant messaging interface or infrastructure to send and receive ink data (See Sun, FIG. 7 and accompanying description). However, Sun does not disclose, suggest or teach to "directly input" ink data into a recording field having instant message text and "annotate said one or more instant text messages in said chat record."

In the Final Office Action, the Examiner alleges that Sun discloses using handwritten [sic] in a chat system and that if one can use the handwriting in a chat system, it would have been obvious to one with ordinary skill in the art to implement handwritten stroke information message

objects anywhere within recording field to thereby annotate one or more instant text message in the chat record. The Examiner cannot base obviousness upon what a person skilled in the art could, or might, try but rather must consider what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner must show a motivation to combine the references that create the case of obviousness. In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. July 15, 1998). The conclusion asserted by the Examiner represents an impermissible use of hindsight gained from the present invention.

For at least the above reason, the references alone or in combination do not teach or suggest all the claim limitations, and therefore, the Examiner has failed to meet at least one prong of prima facie case of obviousness.

In addition, combining Shiigi and Sun is improper because each of these references fails to suggest or disclose a motivation for combining the references. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. MPEP §2143.01 (citing, In re Kahn, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)). Neither Shiigi that discloses an email system nor Sun that discloses using chat system infrastructure for communicating ink data provides the requisite teaching, suggestion, or motivation to make the combination to arrive at the claimed invention.

Furthermore, even if the references could be combined, the Examiner has not shown that there would be a reasonable expectation of success. For example, combining Shiigi and Sun still would not result in the claimed invention, for instance, because the combination would not produce directly inputting ink data into a recording field having instant message text and thereby annotate said one or more instant text messages in said chat record.

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In view of the foregoing, it is respectfully submitted that, independent claims 1, 19, 36 and 53 are not obvious under 35 U.S.C. §103(a), over Shiigi and Sun, as the Examiner has failed to present the prima facie case of obviousness.

2. CLAIMS 2-13, 18, 20-30, 35, 37-47, 52, and 54-55

Claims 2-13, 18, 20-30, 35, 37-47, 52, and 54-55, which depend directly or indirectly from the independent claims 1, 19, 36, and 53 incorporate all of the limitations of the independent claims 1, 19, 36, and 53, and therefore, are not obvious over Shiigi and Sun at least for those reasons provided for claims 1, 19, 36, and 53.

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B. **The rejection of claims 14-17, 31-34 and 48-51,**
on appeal, under 35 U.S.C. § 103,
as being unpatentable over Shiigi and Sun
further in view of Lloyed is improper

      1.   <u>CLAIMS 14-17, 31-34 and 48-51</u>

As discussed, Shiigi and Sun, whether taken alone or in combination, do not teach or suggest the subject matter recited in independent claims 1, 19, 36 and 53. Because Lloyd does not teach or suggest the elements of claims 1, 19, 36 and 53 that Shiigi and Sun fail to disclose, Lloyd is irrelevant. Appellants thus believe that Shiigi, Sun, and Lloyd, whether taken alone or in combination, do not teach or suggest the subject matter recited in claims 1, 19, and 36. Claims 14-17, 31-34, and 48-51, which depend directly or indirectly from the independent claims 1, 19, 36 and 53 incorporate all of the limitations of the corresponding independent claims and are not therefore obvious over Shiigi, Sun, and Lloyd for at least those reasons provided for independent claims 1, 19, 36 and 53.

Respectfully submitted,

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APPENDIX A

CLAIMS ON APPEAL: CLAIMS 1-55
Application Serial No. 10/081,941

1.   (Rejected) A method for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers comprising:

establishing by at least some of the network of computers a connection to said instant messaging system;

providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field;

displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session;

directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record;

distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field.

2.   (Rejected) The method for messaging as claimed in Claim 1, wherein said message objects are IM objects.

3.   (Rejected) The method for messaging as claimed in Claim 1 further comprising copying a plurality of messages from other applications.

4.   (Rejected) The method for messaging as claimed in Claim 1 wherein said messaging system is of a peer-to-peer type.

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5.   (Rejected) The method for messaging as claimed in Claim 1, further comprising forwarding said handwritten stroke information to at least one participant.

6.   (Rejected) The method for messaging as claimed in Claim 1, wherein said messaging system updates chat record of all said current messages for distribution to, and handwritten stroke information annotation by, users of said messaging system, said method further comprising appending said handwritten stroke information onto said chat record.

7.   (Rejected) The method for messaging as claimed in Claim 1, wherein said establishing said connection is initiated by a first of a plurality of said users of said messaging system.

8.   (Rejected) The method for messaging as claimed in Claim 7, wherein said graphical user interface comprises a handwritten stroke input field.

9.   (Rejected) The method for messaging as claimed in Claim 8, wherein said graphical user interface comprises an awareness field.

10.   (Rejected) The method for messaging as claimed in Claim 8, wherein said graphical user interface comprises a text input field.

11.   (Rejected) The method for messaging as claimed in Claim 10, further comprising entering text into said text input field wherein said text is associated with said message objects for transmission to said messaging system.

12.   (Rejected) The method for messaging as claimed in Claim 8 further comprising entering handwritten stroke information into said handwritten stroke input field wherein said handwritten stroke information is associated with said message objects for transmission to said messaging system.

13.   (Rejected) The method for messaging as claimed in Claim 8, further comprising logging and displaying a complete history of said messages in said recording field of said graphical user interface.

14.   (Rejected) The method for messaging as claimed in Claim 13, wherein any one of said messages contains at least one URL for providing location information of an associated said message objects in said recording field.

15.   (Rejected) The method for messaging as claimed in Claim 14, wherein each of said plurality of users may navigate through said recording field to said associated said message objects by selecting said at least one URL whereby said associated said message objects are displayed to said plurality of users.

16.   (Rejected) The method for messaging as claimed in Claim 15, further comprising:
annotating of said instant text messages in said recording field by any of said plurality of users; and using said hyperlink for alerting said plurality of users of said annotation.

17.   (Rejected) The method for messaging as claimed in Claim 16, wherein said annotating

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comprises:

    a) navigating to a desired said message object in said recording field;

    b) selecting the desired said message to be annotated; and

    c) adding new handwritten stroke information message objects to said recording field.

18.   (Rejected) The method for messaging as claimed in Claim 13, further comprising searching said recording field based on user selected criteria.

19.   (Rejected) A computer program product comprising:

    a computer usable medium having computer readable program code embodied therein for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers, the computer readable program code in said computer program product comprising:

    first computer readable program code for causing the computer to:

    a) establish a connection to said instant messaging system;

    b) provide to a plurality of users via said instant messaging system a graphical user interface comprising a recording field;

    c) display in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session;

    d) receive directly input handwritten stroke information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record;

    c) distribute via said instant messaging system said annotated one or more text messages for viewing by said plurality of users in said recording field.

20.   (Rejected) The computer program product for messaging as claimed in Claim 19, wherein:

said message objects are IM objects.

21.   (Rejected) The computer program product for messaging as claimed in Claim 19, further comprising computer readable program code for causing the computer to copy a plurality of messages from other applications.

22.   (Rejected) The computer program product for messaging as claimed in Claim 19, further comprising computer readable program code for causing the computer to forward said handwritten stroke information to at least one participant.

23.   (Rejected) The computer program product for messaging as claimed in Claim 19, further comprising computer readable program code for causing the computer to append said handwritten stroke information onto said chat record.

24.   (Rejected) The computer program product for messaging as claimed in Claim 19, comprising computer readable program code for causing the computer to allow said establishing said connection to be initiated by a first of a plurality of users of said messaging system.

25.   (Rejected) The computer program product for messaging as claimed in Claim 24, comprising computer readable program code for causing the computer to:

a) include a handwritten stroke input field in said graphical user interface.

26.   (Rejected) The computer program product for messaging as claimed in Claim 25, comprising computer readable program code for causing the computer to provide an awareness field.

27.   (Rejected) The computer program product for messaging as claimed in Claim 25, comprising computer readable program code for causing the computer to provide a text input field.

28.   (Rejected) The computer program product for messaging as claimed in Claim 27, comprising computer readable program code for causing the computer to make text entered into said text input field a part of said message objects.

29.   (Rejected) The computer program product for messaging as claimed in Claim 25, comprising computer readable program code for causing the computer to make handwritten stroke information entered into said handwritten stroke input field a part of said message objects.

30.   (Rejected) The computer program product for messaging as claimed in Claim 25, comprising computer readable program code for causing the computer to enable said recording field in said graphical user interface to log and display a complete history of said messages.

31.   (Rejected) The computer program product for messaging as claimed in Claim 30, comprising computer readable program code for causing the computer to place in any one of said messages at least one URL for providing location information of an associated said message objects in said recording field.

32. (Rejected) The computer program product for messaging as claimed in Claim 31, comprising computer readable program code for causing the computer to provide each of said plurality of users the capability to navigate through said recording field to said associated said message objects by clicking on said at least one URL whereby said associated said message objects are displayed to said each of said plurality of users.

33. (Rejected) The computer program product for messaging as claimed in Claim 32, comprising computer readable program code for causing the computer to:

provide the capability of annotation of said messages in said recording field by any of said plurality of users; and

alert said plurality of users of said annotation by said hyperlink.

34. (Rejected) The computer program product for messaging as claimed in Claim 33, comprising computer readable program code for causing the computer to provide the following capabilities in said annotation:

a) navigation to a desired said message object in said recording field;

b) selection of the desired said message to be annotated; and,

c) addition of new handwritten stroke information message objects in said recording field.

35. (Rejected) The computer program product for messaging as claimed in Claim 30, comprising computer readable program code for causing the computer to provide searching of said recording field based on user selected criteria.

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36.   (Rejected) A system for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers comprising:

a) means for establishing a connection to said instant messaging system;

b) means for providing to a plurality of users a graphical user interface comprising a recording field;

c) means for displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session;

d) means for directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one ore more text messages in said chat record; and

e) means for distributing said annotated one or more instant text messages for viewing by said plurality of users in said recording field.

37.   (Rejected) The system for messaging as claimed in Claim 36, wherein:

said message objects are IM objects.

38.   (Rejected) The system for messaging as claimed in Claim 36 further comprising means for copying a plurality of messages from other applications.

39.   (Rejected) The system for messaging as claimed in Claim 36, wherein said messaging system updates a record of all said current messages for distribution to, and handwritten stroke information annotation by, users of said messaging service, said system further comprising means

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for forwarding said handwritten stroke information to at least one participant.

40. (Rejected) The system for messaging as claimed in Claim 36, further comprising means for appending said handwritten stroke information onto said chat record.

41. (Rejected) The system for messaging as claimed in Claim 36, further comprising means for connecting, when initiated by a first of a plurality of users of said messaging system.

42. (Rejected) The system for messaging as claimed in Claim 41, further comprising: means for including a handwritten stroke input field in said graphical user interface.

43. (Rejected) The system for messaging as claimed in Claim 42, comprising means for providing an awareness field.

44. (Rejected) The system for messaging as claimed in Claim 42, comprising means for inputting text.

45. (Rejected) The system for messaging as claimed in Claim 44, comprising means for making said text a part of said message objects.

46. (Rejected) The system for messaging as claimed in Claim 42, comprising means for making handwritten stroke information a part of said message objects.

47. (Rejected) The system for messaging as claimed in Claim 42, comprising means for

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displaying a complete history of said messages.

48.   (Rejected) The system for messaging as claimed in Claim 47, comprising means for providing location information of an associated said message objects of any one of said messages in said recording field.

49.   (Rejected) The system for messaging as claimed in Claim 48, comprising means for providing for each of said plurality of users, quick navigation through said recording field to said associated said message objects, whereby said associated said message objects are displayed to said each of said plurality of users.

50.   (Rejected) The system for messaging as claimed in Claim 49, comprising:

means for annotating of said messages in said recording field by any of said plurality of users;

means for alerting said plurality of users of said annotation.

51.   (Rejected) The system for messaging as claimed in Claim 50, comprising:

means for navigating by a user to a desired said message object in said recording field;

means for selecting the desired said message for annotation by said user; and

means for adding said new handwritten stroke information message objects to said recording field.

52.   (Rejected) The system for messaging as claimed in Claim 47, comprising means for search of said recording field based on user selected search criteria.

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53.   (Rejected) A method for annotating instant text messages in an instant messaging system for communication within an interconnected network of computers comprising:

establishing by at least some of the network of computers a connection to said instant messaging system;

providing to a plurality of users by said instant messaging system a graphical user interface comprising a recording field;

displaying in said recording field for viewing by said users a chat record comprising one or more instant text messages from a currently ongoing instant text messaging session;

directly inputting information message objects anywhere within said recording field to thereby annotate said one or more instant text messages in said chat record;

distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field.

54.   (Rejected) The method for messaging as claimed in Claim 53, further comprising:

a. inputting said information message objects wherein said information comprises speech;

b. annotating said information message objects wherein said annotating comprises speech.

55.   (Rejected) The method for messaging as claimed in Claim 53, further comprising:

a. inputting said information message objects wherein said information comprises gestures;

b. annotating said information message objects wherein said annotating comprises gestures.

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APPENDIX B

EVIDENCE SUBMITTED
Application Serial No. 10/081,941

There is no evidence relied upon by the Appellants in this appeal.

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APPENDIX C

RELATED PROCEEDINGS
Application Serial No. 10/081,941

There are no pending appeals or interferences related to this application to Appellants'

knowledge.

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